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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,651	11/10/2003	Linda S. Higgins		6148
75	590 04/21/2006		EXAM	INER
ZXIBIX. INC.	•		HOLMES, M	IICHAEL B
ATTN: LINDA	. S. HIGGINS			
P.O. BOX 8471			ART UNIT	PAPER NUMBER
SALEM, MA 01971			2121	
			DATE MAILED: 04/21/2006	ς.

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)	
Office Action Summary		10/705,651	HIGGINS ET AL.	
		Examiner	Art Unit	
		Michael B. Holmes	2121	
	The MAILING DATE of this communication	appears on the cover sheet wi	th the correspondence address	
Period fo	- · ·			
WHIC - Exte after - If NC - Failt Any	IORTENED STATUTORY PERIOD FOR RECHEVER IS LONGER, FROM THE MAILING ensions of time may be available under the provisions of 37 CFI r SIX (6) MONTHS from the mailing date of this communication of period for reply is specified above, the maximum statutory peure to reply within the set or extended period for reply will, by streply received by the Office later than three months after the meted patent term adjustment. See 37 CFR 1.704(b).	G DATE OF THIS COMMUNIO  R 1.136(a). In no event, however, may a r  riod will apply and will expire SIX (6) MON tatute, cause the application to become AB	CATION.  eply be timely filed  ITHS from the mailing date of this communication  BANDONED (35 U.S.C. § 133).	
Status				
1)  又	Responsive to communication(s) filed on 1	0 November 2003		
		This action is non-final.		
•	Since this application is in condition for allo		ers, prosecution as to the merits is	
,—	closed in accordance with the practice und		-	
Disposit	ion of Claims	• •	·	
·	Claim(s) <u>1-30</u> is/are pending in the applicat	ion		
٠/ڪ	4a) Of the above claim(s) is/are with		·	
5)	Claim(s) is/are allowed.			
· —	Claim(s) <u>1-30</u> is/are rejected.			
-	Claim(s) is/are objected to.			
8)□	Claim(s) are subject to restriction an	d/or election requirement.		
Applicat	ion Papers			
· ·	The specification is objected to by the Exam	niner		
-	The drawing(s) filed on <u>10 November 2003</u>		objected to by the Examiner.	
•—	Applicant may not request that any objection to			
	Replacement drawing sheet(s) including the cor			
11)	The oath or declaration is objected to by the		•	
ີ riority ເ	under 35 U.S.C. § 119			
	Acknowledgment is made of a claim for fore  ☐ All b)☐ Some * c)☐ None of:		119(a)-(d) or (f).	
	1. Certified copies of the priority docum			
	2. Certified copies of the priority docum			
	3. Copies of the certified copies of the p		received in this National Stage	
* 0	application from the International Bur		aa aa baa d	
	See the attached detailed Office action for a	list of the certified copies not	eceived.	
Attachmen	t(s) e of References Cited (PTO-892)	4 <b>1</b> 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1		
2) 🔲 Notic	e of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s	ummary (PTO-413) )/Mail Date	
3) 🛛 Infor	mation Disclosure Statement(s) (PTO-1449 or PTO/SB/ r No(s)/Mail Date <u>03112004/09232004</u> .	(08) 5) Notice of In 6) Other:	formal Patent Application (PTO-152)	
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Application/Control Number: 10/705,651

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## Examiner's Detailed Office Action

1. Claims 1-30 have been examined.

## Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 3. The invention as disclosed in claims 1-30 are rejected under 35 U.S.C. 101 as being non-statutory subject matter.
- 4. The claims 1-30 constitutes software modules devoid of any apparent hardware, and therefore are computer programs e.g., functional descriptive material. Since the computer programs are not embodied on an appropriate computer-readable storage medium. They cannot be afforded patent eligibility.
- 5. Moreover, the claimed invention as a whole must accomplish a practical application i.e., it must produce a "useful, concrete and tangible result." As per claims 1-30, of which, is silent regarding a practical application, and thus, is insufficient to establish a real world "tangible"

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result. Devoid of such it qualifies applicant's claimed invention as an abstract idea e.g., a computational model or a mathematical manipulation of a function or equation, or whatever, as such, a process that merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might inherently have some usefulness. In re Sarkar, 588 F.2d at 1335, 200 USPQ at 139, the court explained why this approach must be followed:

No mathematical equation can be used, as a practical matter, without establishing and substituting values for the variables expressed therein. Substitution of values dictated by the formula has thus been viewed as a form of mathematical step. If the steps of gathering and substituting values were alone sufficient, every mathematical equation, formula, or algorithm having any practical use would be per se subject to patenting as a "process" under 101. Consideration of whether the substitution of specific values is enough to convert the disembodied ideas present in the formula into an embodiment of those ideas, or into an application of the formula, is foreclosed by the current state of the law.

6. A claim is limited to a practical application when the method or system, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. See AT &T, 172 F.3d at 1358, 50 USPQ2d at 1452. See MPEP § 2106(IV) Applicant is advised to make the appropriate corrections in an attempt to gain patentability. The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. Remember, the claims define the property rights provided by a patent, and thus require careful scrutiny. Therefore, it is not enough to set forth invention in the specification. Finally, the claims must also reflect the scope and breath of applicant's inventtion. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

Limitations appearing in the specification but not recited in the claim are not read into the claim. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551(CCPA 1969).

Correspondence Information

7. Any inquires concerning this communication or earlier communications from the

examiner should be directed to Michael B. Holmes, who may be reached Monday through

Friday, between 8:00 a.m. and 5:00 p.m. EST. or via telephone at (571) 272-3686 or facsimile

transmission (571) 273-3686 or email Michael.holmesb@uspto.gov.

If you need to send an Official facsimile transmission, please send it to (703) 746-7239.

If attempts to reach the examiner are unsuccessful the Examiner's Supervisor, Anthony

Knight, may be reached at (571) 272-3687.

Hand-delivered responses should be delivered to the Receptionist @ (Customer Service

Window Randolph Building 401 Dulany Street Alexandria, VA 22313), located on the first floor

of the south side of the Randolph Building.

Michael B. Holmes

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Patent Examiner
Artificial Intelligence

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United States Department of Commerce

Patent & Trademark Office

Saturday, April 08, 2006

**MBH** 

Anthony Knight

Supervisory Patent Examiner

Group 3600